

# **EXHIBIT S**

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DATE: 22 December 2005

TO: Examiner: Naoko N. Slack  
Group Art Unit 2800

FAX #: 1 571 273 8300

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Application No.: 10/805,686  
Applicant: MORRIS  
Due Date: 1 August 2005

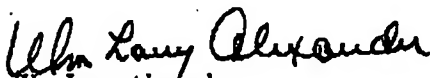
OUR REF.: 1915.17US03

FROM: Wm. Larry Alexander  
PHONE #: (612) 349-5757

Attached please find the following documents for filing in the above-identified patent application:

1. Amendment to 22 November 2005 Office Action.

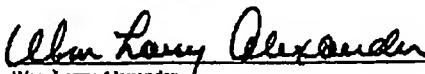
Sincerely,

  
Wm. Larry Alexander  
Reg. No. 37,269

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

MERGED REISSUE AND REEXAMINATION PROCEEDINGS

Attorney Docket No.: 1915.17US03  
Reissue Application No.: 10/805,686  
Confirmation No.: 8616  
Filed: 19 March 2004

Attorney Docket No.: 1915.17US05  
Reexamination Control No.: 90/007,487  
Confirmation No.: 5214  
Filed: 29 March 2005

Examiner: Naoko N. Slack  
Group Art Unit: 2800  
In re the application of: Richard J. Morris  
For: ROOF BATTEN

AMENDMENT

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

In response to the 22 November 2005 Office Action, amendment to the above-identified patent application is requested.

The present amendment comprises the following sections:

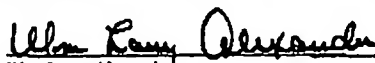
- A. Amendments to the Claims; and
- B. Remarks.

*Please grant any extension of time necessary for entry; charge any fee due to Deposit Account No. 16-0631.*

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12/22/2005 18:27 FAX 6123499266

PATTERSON THUENTE SKAAR

003/010

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AMENDMENTS TO THE CLAIMS

Please cancel claim 21.

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**REMARKS**

Applicants' attorney gratefully acknowledges the constructive and cordial interview granted by the Examiner in which the documents cited against the pending claims were discussed. The Examiner and Applicant's attorney also addressed the proper construction of the term "tile" and, for reasons stated below, Applicant submits that none of the documents cited against the pending claims discloses or suggests this limitation.

Claims 2-13 are pending, claim 21 having been canceled by this amendment.

**35 U.S.C. § 102**

Claims 2-11 and 13 are rejected under 35 U.S.C. § 102(b) as anticipated by Morris (U.S. 5,304,095); and claim 21 is rejected under 35 U.S.C. § 102(b) as anticipated by Erickson (U.S. 3,878,574). Applicant respectfully traverses the rejection of claims 2-11 and 13. Because claim 21 is canceled, the rejection regarding claim 21 is rendered moot.

In order to establish a prima facie case of anticipation, every limitation in the claim asserted to be anticipated must be disclosed in a single prior art reference.<sup>1</sup> Applicant respectfully submits that not all limitations of claims 2 and 3 are taught or suggested by Morris. Morris fails to disclose or suggest (1) a tile roof system having (2) a batten to support and separate the tiles from the roof to provide ventilation and water drainage underneath the tile. Indeed, the disclosure of Morris is limited to a shingle roof

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<sup>1</sup> M.P.E.P. § 2131.

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system where shingles attach directly to the roof to prevent ventilation and water infiltration below the shingles. Unlike Morris, the present Applicant's claimed invention is directed to a tile roof system having a batten to support and separate the tiles from the roof to provide ventilation and water drainage underneath the tile.<sup>2,3</sup> Conversely, the teachings of Morris are limited to a shingle roof system where shingles attach directly to the roof to prevent ventilation and water infiltration below the shingles and spacing from the roof.<sup>4</sup>

It is well understood to those skilled in the art that the water infiltration characteristics and ventilation needs of tile roof systems are quite different and incompatible with that of shingle systems.<sup>5</sup> Tile roof systems, like those disclosed and

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<sup>2</sup> U.S. 6,357,193, column 4, beginning at line 44 ("battens 30 function to space tile 110 from the remainder of roof 100 and to drain water which has infiltrated between installed tiles 110, thereby preventing the infiltrated water from pooling atop overlayment 102 and preventing the water from penetrating into the decking and structural members of roof 100. Also as installed on roof 100, channels 58 of battens 30 serve as conduits for air exchange beneath tiles 110, thereby further promoting evaporation of infiltrating water.").

<sup>3</sup> U.S. 6,357,193, column 1, beginning at line 26 ("Separation between tiles and overlayment is necessary to ensure that water infiltrating the tiles onto the felt paper evaporates quickly. If water is otherwise allowed to stand or pool, the water may infiltrate through the felt paper and penetrate the roof decking, thereby potentially causing deterioration of the roof decking and the underlying framework.").

<sup>4</sup> U.S. 5,304,095, Figures 1 and 7 (showing shingles 24 directly attached to - not spaced apart from - the overlay 22).

<sup>5</sup> "Concrete tile is also very heavy, and poses both a safety risk and cost premium because it can be up to 400 percent heavier than the heaviest architectural asphalt singles - needing more reinforcement in the home's structure to hold the weight and protect against earthquakes or high winds. It is inherently not waterproof - relying on longevity and durability of the underlayment to maintain the building moisture integrity. It has an inconsistent quality, with colorations that are hard to match and works only with limited architectural styles. It also absorbs moisture, provides a place for algae to grow, and has

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claimed as part of the present invention, include relatively heavy and thick shaped tiles, such as clay or concrete tiles, or the like.<sup>6</sup> As seen in Figure 10, tiles with the foregoing features are installed on the instant battens so as to be spaced apart from the remainder of the roof. As such, water infiltration below the tile is unavoidable.<sup>7</sup> By contrast, shingle roof systems, such as disclosed in Morris, include relatively thin shingles that are fixed directly to the roof such that water is necessarily shed from the roof along the top of the shingle to prevent the water from contacting the roof deck or the roof felt.<sup>8</sup>

For these reasons, it is respectfully submitted that the shingle roof system of Morris fails to disclose to one skilled in the art the limitations of claims 2 and 3. Namely, Morris fails to teach any tile structure, much less spacing tiles from the roof by a batten, as required in claims 2 and 3.

Because all the limitations of claims 2 and 3 are not disclosed or suggested by Morris, Applicant respectfully submits that Morris does not anticipate these claims. The other rejected claims depend directly or indirectly from claims 2 or 3. Therefore,

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a painted surface which fades over time." ARMA 18 November 2002 News Release (accessible at [http://www.asphaltroofing.org/news\\_pr\\_res2.html](http://www.asphaltroofing.org/news_pr_res2.html)).

<sup>6</sup> U.S. 6,357,193, column 4, beginning at line 57 ("Exemplary roof batten 30 may be utilized with clay or cement tiles, including flat tiles, S-tiles, and barrel tiles. Moreover, while exemplary roof batten 30 is depicted as being used in conjunction with roof tiles, other exterior roof materials including slate, clay, metal, and cedar may also be installed using exemplary roof batten 30.").

<sup>7</sup> U.S. 6,357,193, column 1, beginning at line 25 ("Separation between tiles and overlayment is necessary to ensure that water infiltrating the tiles onto the felt paper evaporates quickly.").

<sup>8</sup> U.S.S. 3,04,095, Figures 1, and 6-7, showing the shingles attached directly to the roof overlay with the roof ventilator attached on top of the shingles.

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Applicant respectfully submits that the other rejected claims are not anticipated by Morris as well. Because Applicant submits that none of the rejected claims are anticipated by Morris, reconsideration and withdrawal of the rejection are respectfully requested.

35 U.S.C. § 103(a)

Claim 12 is rejected under 35 U.S.C. § 103(a) as obvious over Morris (5,304,095), in view of Notaro (U.S. 3,647,606). Applicant respectfully traverses this rejection. Applicant first submits that all limitations recited in claim 12 are not present in the combination of Morris and Notaro. Secondly, Applicant respectfully traverses that the required motivation to modify the disclosure of Morris with the disclosure of Notaro has been established.

In order to establish a prima facie case of obviousness, a rejection must cite documents which teach or suggest all the claim limitations.<sup>9</sup> Claim 12 depends indirectly from claim 3. As shown above, Applicant feels that he has shown that Morris fails to disclose or suggest the "tile" recited in claim 3. Applicant also contends that the semirigid multilayer thermal insulation disclosed by Notaro also fails to disclose or suggest a tile, or use with a tile, to a person of ordinary skill in the art. Because neither Morris nor Notaro discloses or suggests the tile recited in claim 3, all the limitations of claim 12 are not taught or suggested.

<sup>9</sup> M.P.E.P. 2143 ("To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.").



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In addition to disclosing or suggesting all claim limitations, a prima facie case of obviousness must also establish a proper motivation for modifying the documents cited against the claims in the manner stated in the rejection.<sup>10</sup> Applicant additionally and respectfully traverses that the requisite motivation to modify the disclosure of Morris with the disclosure of Notaro has been established. The rejection seems to assert that a known limitation inherently provides the requisite modification. However, that a limitation is "known" is not relevant to showing that the required motivation was present.<sup>11, 12</sup> Because a motivation present in the prior art to modify the disclosure of

<sup>10</sup> M.P.E.P. § 2142 ("To establish a prima facie case of obviousness, ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... The teaching or suggestion to make the claimed combination ... must ... be found in the prior art, and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).").

<sup>11</sup> Abbott Laboratories v. Syntron Bioresearch Inc., 67 USPQ2d 1337, 1347 (Fed. Cir. 2003) ("Syntron cites a statement by an expert for Abbott that the use of the fluid sample to drive the flow was known in the prior art. [Citation omitted.] Knowledge in the prior art of every element of a patent claim, however, is not of itself sufficient to render the claim obvious. Graham v. John Deere Co., 383 U.S. 1, 17-18 [149 USPQ2d 459] (1966); Teleflex, Inc. v. Ficoso N. Am. Corp., 299 F.3d 1313, 1328, 63 USPQ2d 1374, 1383 (Fed. Cir. 2002). The issue is whether substantial evidence supports the judgment ... that a person having ordinary skill in the art would not have been motivated to replace the developing fluid/sample solution combination of Deutsch with flow provided solely by sample fluid.").

<sup>12</sup> M.P.E.P. § 2143.01 (IV) ("[B]ecause the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention).")

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Morris with the disclosure of Notaro has not been cited, Applicant respectfully submits that the requisite motivation has not been established.

Evidence of patentability is established if the disclosures of the cited documents actually teach away from the asserted modification.<sup>13</sup> As shown above, Morris discloses shingles affixed directly to, not spaced from, the plywood overlays.<sup>14</sup> Indeed, Morris neither discloses nor suggests the use of spacers between the shingles and the plywood overlays. By neither disclosing nor suggesting using spacers between the shingles and the plywood overlays on roofs, Morris thusly teaches away from using spacers as proposed by the rejection.

Because all the limitations of claim 12 are not disclosed or suggested by Morris and Notaro, because the requisite motivation to modify Morris with Notaro has not been shown, and because Morris actually teaches away from the proposed modification, a prima facie case of obviousness has not been shown and reconsideration and withdrawal of the rejection are respectfully requested.

#### Conclusion

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

<sup>13</sup> MPEP § 2155.05 III ("A prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997)").

<sup>14</sup> U.S. 5,304,095, Figures 1, 6, and 7.

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0010/010

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The Examiner is invited to telephone the undersigned if the Examiner believes it  
would be useful to advance prosecution.

Respectfully submitted,

  
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